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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---|------------------|
| 10/522,519 | 02/28/2005 | Kyoko Yokoi | TIP-05-1007 | 1423 |
| 35811 7590 01/16/2007 IP GROUP OF DLA PIPER US LLP ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA, PA 19103 | | | EXAMINER TORRES VELAZQUEZ, NORCA LIZ | |
| | | | ART UNIT 1771 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/16/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/522,519

Applicant(s)

YOKOI ET AL.

Examiner

Norca L. Torres-Velazquez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12705.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed January 27, 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it fails to provide an English translation of the foreign documents or their Abstracts. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1-4, the phrase "suede-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over HIGUCHI et al. (US 4,525,169).

HIGUCHI et al. discloses an artificial grain leather comprises of ultra fine fibers which are not more than about 0.7 denier. (Col. 2, lines 16-18) The reference teaches needle-punching in the fibrous substrate. (Refer to Col. 3, lines 6-9) The reference teaches the use of polyethylene terephthalate or polybutylene terephthalate fibers. (Col. 3, lines 39-41) HIGUCHI et al. uses polyurethane and polyurethane urea resins in the coating layer. (Col. 5, lines 43-44) The coating layer can be colored-transparent and is made of a coating composition in which resins are mixed with pigments and/or dyestuffs. (Col. 5, lines 59-61) In the Examples the coating compositions include red and blue dyes. (Refer to Col. 9)

Although HIGUCHI et al. does not explicitly teach the claimed properties of infrared reflectance, surface temperature and light fastness it is reasonable to presume that these properties are inherent to the artificial leather of HIGUCHI et al. Support for said presumption is

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found in the use of like materials (i.e. uses a fiber-entangled substrate made of ultra-fine polyester fibers and a polyurethane coating that includes similar dyes). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed properties of infrared reflectance, surface temperature and light fastness would obviously have been present one the HIGUCHI et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

7. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over HIGUCHI et al. as applied above, and further in view of PEDAIN et al. (US 3,867,350).

HIGUCHI et al. is silent to the use of a polycarbonate-based polyurethane.

PEDAIN et al. relates to polyurethane urea elastomers based on polycarbonate macrodiols. (Title; Abstract) The reference teaches the use of the resin for the production of coatings applied to substrates such as leather and artificial leather. (Col. 6, lines 20-31)

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the resin of HIGUCHI et al. and provide it with the polycarbonate based polyurethane of PEDAIN et al. with the motivation of using an elastomer that is less of a physiological hazard, that is more resistant to common solvents and require less emulsifiers and dispersion aid as disclosed by PEDAIN et al. (Abstract)

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

BORRI et al. (US 5,277,969) - discloses an imitation leather laminate material that comprises a base sheet consisting of 50 to 90% by weight of a microfiber felt wherein the microfibers are polyethylene terephthalate of from 0.05 to 0.4 denier [0.056-0.444 dtex], and 50 to 10% by weight of a polyurethane-polyurea polymer. (Abstract; Col. 1, lines 13-16, lines 56-63) The polyurethane-polyurea polymer is impregnated on the felt. (col. 2, lines 14-15) The felt is formed by needle punching. (Col. 4, lines 35 and lines 53-54).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-5:00 pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Norca L. Torres-Velazquez
Primary Examiner
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December 28, 2006